

## **Remarks**

### **I. General Remarks and Disposition of the Claims**

Claims 1-5, 7-9, and 12-14 are pending in this application. Claims 1-5, 7-9, and 12-14 are rejected. Applicants respectfully request reconsideration in light of the remarks contained herein.

### **II. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 103(a)**

Claims 1-5, 7-9, and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,787,000 issued to Lilly et al. (hereinafter “Lilly”) in view of Layden (“A Rapidly Changing Landscape”) (hereinafter “Layden”) in further view of Manugistics<sup>5</sup> (“Manugistics Introduces Industry’s Only Extended Supply Chain Management Solution”) (hereinafter “Manugistics”). Applicants respectfully traverse because the Examiner has not established a *prima facie* case of obviousness because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (hereinafter “MPEP”).

A *prima facie* case of obviousness requires a suggestion or motivation in the prior art references to make the specific combination of elements claimed by Applicants. MPEP § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held *improper*.); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)). The Examiner does not point to any part of the cited prior art references to show such motivation or suggestion to combine the

elements of Lilly in view of Layden to arrive at the specific combination of elements claimed by Applicants.

Examiner writes, in part, as follows:

[T]he Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement these enhancements taught by Layden with the details of Lilly's production planning and scheduling system in order to reap these benefits (i.e., making the order-driven manufacturing process more efficiently and effectively responsive to new customer orders, priority orders, last-minute customer changes, etc.).

(Office Action at 5-6.)

Applicants acknowledge that motivation for combination of Lilly and Layden may come from the knowledge of a person of ordinary skill in the art. In this case, however, the Examiner has not shown through a reference or any other evidence that a person of ordinary skill would be motivated to combine the references. Based on this lack of evidence, Applicants can only assume that the combination of Lilly and Layden was motivated by the teaching of Applicants' own disclosure. This is the type of reasoning that the Federal Circuit has repeatedly cautioned against. *See, e.g., In re Sang Su Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430 (Fed. Cir. 2002). In *Lee*, the Federal Circuit revered an obviousness rejection where the cited motivation for combination was based on "common sense." The Court went on to say that:

The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or

effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

(*In re Sang Su Lee*, 277 F.3d at 1345, 61 USPQ2d at 1435).

In the present case, as in *Lee*, the knowledge of the person having skill in the art that the Examiner is using to reject the claims has not been “articulated and placed on the record.” The rejection of claim 1 is therefore based merely on impermissible hindsight reasoning.

Further, as provided in MPEP § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to combine or modify the prior art references, Applicants hereby respectfully traverse the lack of such a showing and request under MPEP § 2144.03(C) that Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification and/or combination of elements to arrive at Applicants’ invention.

Additionally, Applicants respectfully point out that the Federal Circuit has made clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680,682 (Fed. Cir. 1990)). The MPEP also makes clear the requirement that Examiner provide objective reasons to combine the references apart from naked statements that “it would be obvious to a person of ordinary skill.” MPEP § 2143.01 (explaining that “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the

claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." (citations omitted)).

Thus, Applicants respectfully submit that the Examiner has not cited where in Lilly and Layden references suggest the motivation to combine or to modify the references to arrive at the specific combination of elements of Applicants' claims. Thus, Applicants respectfully request the removal of the 35 U.S.C. § 103(a) rejection as to dependent claims 2-5, 7-9, and 12-14 which depend from independent claim 1.

### **III. No Waiver**

All of Applicants' arguments are without prejudice or disclaimer. Additionally, Applicants have merely discussed why the Lilly and Layden references should not be combined. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The arguments made by Applicants are sufficient to overcome the obviousness rejection.

**Conclusion**

Applicants respectfully submit that the rejection of claims 1-5, 7-9, and 12-14 should be withdrawn and that these claims should be passed to issuance.

Respectfully submitted,



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